•• REMARKS/ARGUMENTS ••

The present Supplemental Amendment is being filed together with a Request for Continued Examination (RCE) of the above-identified application.

By the present Supplemental Amendment the limitations of dependent claim 4 regarding the use of epoxy silane coupling agents and methacryloxy coupling agents have been incorporated into independent claim 1 and dependent claim 4 has accordingly been canceled.

In addition, claim 10 has been changed to be dependent on claim 1.

In addition, dependent claim 7 which recited the same limitations as dependent claim 4 has also been canceled.

The present Supplemental Amendment to the claims addresses and overcomes indefiniteness concerns in the claims that were previously noted by the Examiner in the Advisory Action of January 23, 2004.

In the Official Action of October 23, 2003 the Examiner rejected claims 1, 3-5 and 8-10 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over European Patent Application No. 0 014 336 to Vaidya.

Claims 1-3, 5 and 9 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,484,844 to Oshima et al. or U.S. Patent No. 5,914,195 to Hori et al.

The Examiner has relied upon Vaidya as showing "chlorinated polyethylene copolymers having the chlorination percent as requisite claim 1."

The Examiner states that "[t]he instantly claimed coupling agent is exemplified at page 8" in Vaidya.

Vaidya flails to teach either an epoxy silane coupling agent or a methacryloxy coupling agent.

Accordingly, Vaidya fails to anticipate applicants' claimed invention.

Oshima et al. is directed to vinyl chloride resin elastomer compositions which have excellent compression set as "demanded for materials of e.g. glass runs and weather strips."

Hori et al. is directed to thermoplastic resin compositions that are "excellent in creep resistance and bond strength" and which are useful as sealing materials and gaskets.

Neither Oshima et al. nor Hori et al. teach applicants' claimed epoxy silane coupling agents and methacryloxy coupling agents in combination with chlorinated polyethylene, let alone any a composition that would resist blistering when in contact with carbon dioxide.

The Examiner appears to be taking the position that the various prior art references teach compositions that would "inherently" be useful in conjunction with carbon dioxide refrigerants.

As held by the court of appeals in *In re Shetty*:

> Inherency is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result.
>
> The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is known. (*In re Shetty*, 195 USPQ 753(CCPA 1977))

In the present case, the use of chlorinated polymer compositions does not lead to the conclusion that the prior art compositions are useful in conjunction with carbon dioxide refrigerants or that all chlorinated polymer compositions can be used to make sealing elements that will effectively seal carbon dioxide.

Inherency cannot be found in the present case where the prior art fails to recognize the use of applicants' claimed molding materials, especially when the claims recite the limitation of a "molding material for use with carbon dioxide refrigerant.

It is believed that the phrase "for use with carbon dioxide refrigerant" breaths life and meaning into the claims. Note the court of appeals holding in *Loctite Crop.*:

> Term in preamble of patent claim breathes life and meaning into the claims and hence is a necessary limitation to them. *Loctite Corp. v. Ultraseal, Ltd.*,228 USPQ 90, at 92 (CAFC 1985)

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

Moreover, the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

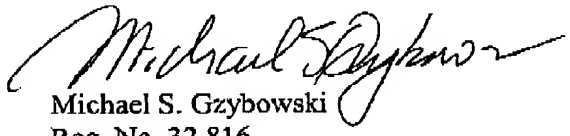
It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art or record and the outstanding rejections of the claims should hence be withdrawn.

Entry of the present Supplemental Amendment prior to continuation of the examination of the application is respectfully requested.

If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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